

REMARKS

Applicants hereby submit this Communication, Request for Reconsideration and Amendment B, responsive to Examiner Levitan's telephone conversations with the office of Applicants' Attorney on May 18, 24, 25 and 26, 2004; Examiner Kizou's telephone conversation with Applicants' Attorney on June 1, 2004 and to the Advisory Action—Date Mailed: May 28, 2003, Paper No. 10, for which a response is due March 03, 2004 by a shortened statutory period for reply set to expire three months from the mailing date of the Office Action.

During the afore-mentioned conversations regarding the previously submitted and not entered Amendment B (originally submitted March 1, 2004, and re-transmitted May 18, 2004; responsive to the Final Office Action—Date Mailed: December 03, 2003, Paper No. 6), Examiner Levitan stated that he did not understand the role of the second named inventor, because the disclosure of the present above-referenced patent application is the same as the disclosure of its parent (U.S. Patent No. 6,272,131), and the first named inventor of the present application was the sole inventor of its parent (U.S. Patent No. 6,272,131).

Examiner then states in the afore-mentioned Advisory Action:

The amendment to the specification raises [a] new issue concerning the inventorship under 102f. Claiming priority to Dr. Ofek patent basically implies that Mr. Baldi is not the inventor of the claimed invention, since the invention is fully disclosed and anticipated by the patent to Dr. Ofek to which Mr. Baldi had no contribution. In other words, Dr. Ofek is a sole inventor of the mentioned parent applicatio[n]/patent including all claims. This continuation-in-part is fully anticipated by the parent application/parent and raise[s] a question of the contribution of the second author[] to the invention.

Subsequent to the receipt of the above Advisory Action, Applicants' Attorney, David Sitrick, had a telephone conversation with Supervisory Examiner Hassan Kizou on June 1, 2004. Supervisory Examiner Kizou advised Applicants' Attorney of two methods of overcoming the afore-mentioned objection: (1) file a petition to drop the second, joint inventor, Mario Baldi, from the present application; or (2) file a petition to add the second, joint inventor, Mario Baldi to the parent application/patent (U.S. Patent No. 6,272,131). Applicants' Attorney discussed this matter with Applicants, and Applicants determined to file 37 CFR 1.324. Petitions For Correction of Inventorship in U.S. Patent No. 6,272,131, Pursuant To 35 U.S.C. 256.

37 CFR 1.324. Petitions For Correction of Inventorship in U.S. Patent No. 6,272,131, Pursuant To 35 U.S.C. 256 by the First Named Inventor, Yoram Ofek; the added Second, Joint

PATENT APPLICATION
Serial Number: 09/535,831
Attorney Docket Number: SYN 1756

Inventor, Mario Baldi; the Assignee, Synchrodyne Networks, Inc. have been submitted to the U.S.P.T.O. by facsimile transmission on today's date, June 3, 2004, accompanied by the appropriate fee transmittal. A copy of this transmission is herewith provided for Examiner's convenience. Applicants respectfully submit that any and all bases of objection and rejection under 35 USC 102 (f) are hereby traversed and overcome. As Applicants have now satisfied Examiners' requirements to overcome any question as to inventorship, Applicants hereby request Reconsideration After Final, so that the following Amendment B may be entered into the record.

Claims 21-52, 54-67, 82-86 and 89-91 are currently pending in the application. Claims 21-52, 54-67, 82-86 and 89-91 are rejected.

Applicants hereby submit this Amendment B, responsive to the Final Office Action—
Date Mailed: December 03, 2003, Paper No. 6, for which a response is due March 03, 2004 by a shortened statutory period for reply set to expire three months from the mailing date of the Office Action.

Claims 21-52, 54-67, 82-86 and 89-91 are currently pending in the application. Claims 21-52, 54-67, 82-86 and 89-91 are rejected.

By this Amendment, the Specification has been amended. A Substitute, New Declaration for Utility Patent Application (37 CFR §1.63) is herewith filed. Applicants wish to thank Supervisory Patent Examiner Hassan Kizou for his telephone conference with Applicants' Attorney on February 12, 2004.

In light of this New Declaration, Applicants respectfully submit that Examiner's rejections of Claims 21-52, 54-67, 82-86 and 89-91 under 35 U.S.C. §102(e) as being anticipated by Ofek (US 6,272,131) are improper and request Examiner to withdraw the Final Office Action. The previously submitted Amendment A, filed August 12, 2003, claimed priority for the present application from Ofek (US 6,272,131) and declared the present application to be a continuation-in-part of Ofek (US 6,272,131).

By virtue of the petitions filed today, the inventorship of US 6,272,131 was corrected to name both Yoram Ofek and Mario Baldi as inventors. Thus, both the present application and parent application/patent (US 6,272,131) name Yoram Ofek and Mario Baldi as common inventors. Both the present application and parent application/patent (US 6,272,131) are assigned to a common owner: Synchrodyne Networks, Inc. The subject matter of the various claims was commonly owned at the time of filing Applicants' present invention, as

acknowledged by Applicants' Declaration which is filed concurrently with this Amendment B. An Assignment assigning all patent rights to Synchrodyne Networks, Inc. (duly executed by both of the joint inventors of the present Application) was filed by Applicants' Attorney of record on March 28, 2000. Therefore, there is complete identity of inventorship and common ownership of the present application and its parent application/patent (US 6,272,131).

35 U.S.C. §120 provides that a continuation application must be filed by "an inventor or inventors named in the previously filed application." The 1984 amendment to 35 U.S.C. §120 directly allows continuation, divisional, and continuation-in-part applications to be filed even though there is not complete identity of inventorship between the parent and subsequent applications.

37 C.F.R. §1.78(a)(1) provides that "In order for an application to claim the benefit of a prior-filed copending nonprovisional application... each prior-filed application must name as an inventor at least one inventor named in the later-filed application and disclose the named inventor's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112." The impact of this rule can be avoided by naming inventor A in the second application and stating some claim supported by the prior application as to which A is a joint or sole inventor. Disclosure support in the Specification of Ofek (US 6,272,131) exists for all claims of the currently pending application.

37 C.F.R. §1.78(a)(2) provides that "Except for a continued prosecution application... any nonprovisional application... claiming the benefit of one or more prior-filed application... must contain or be amended to contain a reference to each such prior-filed application identifying it by application number (consisting of the series code and serial number)... and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (see §1.14)." Applicants have already complied with 37 C.F.R. §1.78(a)(2) in Amendment A (filed: August 12, 2003) of the currently pending application.

It is respectfully submitted that in light of this Communication, Request for Reconsideration, Amendment B and the concurrently filed Petitions For Correction of Inventorship in U.S. Patent No. 6,272,131, that the Final Rejection is improper and premature, and that the Final Office Action should be withdrawn.

This response is accompanied by the appropriate fee transmittal authorizing the Commissioner to charge any additional fees and credit any overpayments during the pendency of

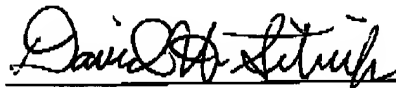
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this application to Sitrick & Sitrick's Deposit Account Number: 501166. Additional fees for a three-month extension of time and the Substitute, New Declaration (attached herewith) are due and paid via said fee transmittal form.

It is thus respectfully submitted that by this amendment all basis of objection and rejection have been traversed and overcome, and that the application, including the specification description, claims and drawings are in proper form for allowance.

The Examiner is invited to communicate directly with the undersigned via phone as would be of assistance to expediting prosecution of this matter.

Respectfully submitted,



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June 3, 2004

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